

REMARKS

In the office action, Claims 1-5, 7-11, 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Amin et al. (U.S. Pat. No. 5,953,652) in view of Wical (U.S. Pat. No. 5,694,523) in further view of the Corsair article. Claims 15 and 16 were objected to as being dependent on a rejected base claim. Based on the following remarks, applicant traverses all claim rejections.

Applicant traverses the objection to Claims 15 and 16. The office action states that, "Claims 15, 16 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." (*See Office Action at p. 7*). Applicant notes that Claims 15 and 16, as previously presented, are independent claims and are not dependent on a rejected base claim. Applicant also notes that although the cover page of the office action indicates that Claims 13 and 14 have been allowed, it appears from the text of the remainder of the office action that these claims stand rejected. (*See Office Action at Cover Page, p. 2*.) To expedite prosecution, applicant will proceed herein on the assumption that the Examiner intended to allow Claims 15 and 16 and reject Claims 13 and 14 under 35 U.S.C. § 103(a) as stated at page 2 of the office action. (*See Office Action at p. 2*). If this assumption is incorrect, applicant invites the Examiner to contact the undersigned representative to clarify what was actually intended in the office action.

Claim 1

Applicant traverses the rejection of Claim 1 under 35 U.S.C. § 103(a) over Amin in view of Wical, in further view of the Corsair article and submits that the rejection is improper because, among other reasons, there is no motivation or suggestion to combine the references as suggested in the office action (*See* MPEP § 2143.01):

THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper).

The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). “In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). *See also In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on

objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Applicant submits that the nature of the problem solved by the method of Claim 1 provides no motivation to combine Amin, Wical, and the Corsair article. Even if applicant concedes that Amin and the Corsair article relate to problems in the field of telecommunication networks (*See* Amin at Abstract, Corsair article), it is clear that Wical relates to the different problem of determining, “the content of input discourse, such as input speak (sic) and input text,” that is, determining the meaning of verbal or textual conversations. (*See*, Wical at col. 3, lines 13-14.) Applicant submits that the telecommunications problems addressed by Amin, the Corsair article, and Claim 1 are completely different than the problem addressed by Wical, and further, that the problem types are in completely different fields. Therefore, Applicant submits that there is no motivation to combine Wical with Amin and the Corsair article.

In addition, applicant submits that the teachings of the cited references do not provide a motivation to combine Wical with Amin and the Corsair article. Applicant submits that the speech parsing algorithm of Wical in no way suggests or motivates a combination with the telecommunication network disclosures of Amin and the Corsair article. Applicant also submits that neither Amin nor the Corsair article suggest or motivate combining elements of their respective disclosures with elements from the speech parsing algorithm of Wical. Therefore, Applicant submits that the teachings of the prior art do not provide a motivation to combine the teachings of Wical with those of Amin and the Corsair article.

Applicant also submits that the knowledge of one of ordinary skill in the art does not suggest or motivate combining Wical with Amin and the Corsair article. Applicant submits that one of ordinary skill in the arts relating to telecommunication networks would not be motivated to examine algorithms for speech parsing while developing a system for detecting fraudulent use of a telecommunication network as disclosed in Amin and the Corsair article.

Applicant submits that there is no motivation to combine Wical, Amin, and the Corsair article from the nature of the problem solved, the teachings of the prior art, or the knowledge of those skilled in the art. Therefore, Applicant respectfully requests that the rejection of Claim 1 under 35 U.S.C. § 103(a) be withdrawn.

Claims 2-5

Applicant respectfully traverses the rejections of Claims 2-5. Applicant submits that Claims 2-5 are allowable by virtue of their dependence from Claim 1 as well as on their own merits.

Claim 7

Applicant respectfully traverses the rejection of Claim 7. Applicant submits that Claim 7 is rejected over the same references, and for analogous reasons, described above with reference to Claim 1. Applicant submits that Claim 7 is therefore allowable for the same reasons discussed above with reference to Claim 1.

Claims 8-11

Applicant submits that Claims 8-11 are allowable by virtue of their dependence from Claim 7 as well as on their own merits.

Claim 13

Applicant submits that Claim 13 is rejected over the same references, and for analogous reasons, described above with reference to Claim 1. Applicant submits that Claim 13 is therefore allowable for the same reasons discussed above with reference to Claim 1.

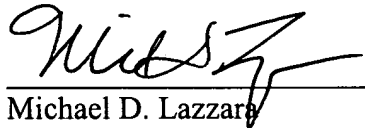
Claim 14

Applicant submits that Claim 14 is allowable by virtue of its dependence from Claim 13 as well as on its own merits.

SUMMARY

Applicant respectfully requests issuance of a notice of allowance for the pending claims in the present application. If the Examiner believes that any outstanding issues need to be addressed in connection with the present application, the Examiner is invited to contact the undersigned representative to discuss any such issues.

Respectfully submitted,



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